



Department of Energy
Washington, DC 20585

MEMORANDUM

September 28, 2004

To: Robert Fisher, Chicago Operations Office
Emily Schneider, Oak Ridge Operations Office
Dickson Kehl, Albuquerque Operations Office
Lisa Jarr, Federal Energy Technology Laboratory

Subject: Background rights in patents and inventions

The financial assistance regulations were revised [68 FR 50646 8/21/03]. Among the changes, the Patent Rights clause was revised to eliminate the requirement for rights in Background Patents to assure commercialization. See specifically, 10 CFR 600.325(3). However, the waiver regulations (10 CFR 784.12) contain a recommended clause which has not yet been revised to eliminate the Background Rights section from the standard waiver, thus creating some confusion. The waiver regulation at 10 CFR 784.12 provides for modification of the standard waiver clause. This memorandum is to make clear that the provisions of the assistance regulations, 10 CFR 600.325(3) control. We are taking steps to modify both the Waiver regulation and the DOE DEAR to conform to the standard established by the Assistance Regulations with respect to use of Background IP clauses to assure commercialization.

A handwritten signature in black ink, appearing to read "P. A. Gottlieb", is positioned above the printed name.

Paul A. Gottlieb
Assistant General Counsel for Technology
Transfer and Intellectual Property

